

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/851,882 05/09/01 GHOSH

D 210556

023460 HM12/1108
LEYDIG VOIT & MAYER, LTD
TWO PRUDENTIAL PLAZA, SUITE 4900
180 NORTH STETSON AVENUE
CHICAGO IL 60601-6780

EXAMINER

YU, G

ART UNIT

PAPER NUMBER

1619

DATE MAILED:

11/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/851,882

Applicant(s)

GHOSH ET AL.

Examiner

Gina C. Yu

Art Unit

1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1-36 and 38-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fänger et al. (U.S. Pat. No. 6,153,204) ("Fänger").

Fänger teaches cosmetic or pharmaceutical compositions comprising antioxidants. See col. 4, line 53 – col. 7, line 68. The o/w emulsion in Example 3 comprises 10 wt % urea, and also contains antioxidant and preservatives to a sufficient quantity. Ubiquinone, vitamin C, tocopherols, and the derivatives thereof are among the conventional antioxidants disclosed in col. 7, lines 13-68. The reference teaches using 0.001-30 wt % of the antioxidants, and in particular 1-10% by weight, which meets the

Art Unit: 1619

limitation of weight ratio of urea and ubiquinone in instant claims 1, 10, and 11. Also disclosed in Example 3 are preservatives and perfume, which meet instant claims 19 and 32. The amount of water in the example is at most 55.5 %, and the oil phase (PEG-7 hydrogenated castor oil, wool wax alcohol, beeswax, Vaseline, paraffin oil) comprise 26.5 wt % of the composition, meeting instant claims 4, 6, and 20. Also disclosed by the reference are: emulsifier, meeting instant claim 12; thickener, claims 14-16; and anti-inflammatory active ingredients claims 23-24. See col. 6, line 63 – col. 7, line 12. The addition of C12-15-alkyl benzoate is also suggested, meeting instant claim 21. See col. 8, lines 63 – 67. Examiner views that the optimum weight range of the additives not mentioned in this reference would have been discovered by a skilled worker by routine experiments.

Although the reference lacks the explicit teaching of particularly selecting ubiquinone from the disclosed antioxidants, the selection would have been obvious to one of ordinary skill in the art at the time the invention was made because of the expectation of obtaining antioxidant benefits in the composition.

2. Claims 1-20, 23-41, and 43-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoppe et al. (U.S. Pat. No. 5,912,272) (Hoppe) in view of Raab (Uses of Urea in Cosmetology, 1990).

Hoppe teaches composition comprising ubiquinones for treating senile xerosis, of which the symptoms include dryness, cracking, roughness skin by providing moisture to the skin. See col. 1, line 9 – col. 2, line 37. The composition preferably comprises 0.2-0.4 by weight of coenzyme Q10. See col. 3, lines 4 – 15. The composition is formulated in W/O or O/W emulsion gel, lotion, or cream. See col. 3, lines 16 – 20; col.

Art Unit: 1619

4, lines 53- 60. The additives including emulsifiers, preservatives, buffer substances, thickeners, fragrances, antioxidants, vitamins, and UV protection filters are also to be added in the composition. See col. 3, line 21 – col. 4, line 48. Given the teaching of adding 0.1-10wt % of the UV protection filters to ensure the stability of the oxidation-sensitive ubiquinones, examiner views that a skilled worker would have known to optimize the quantity of the components in the composition. The reference lacks the teaching of urea and soothing additives.

Raab teaches the use of urea in concentrations of 4-10 wt % in cosmetic and/or dermatological compositions. See p. 97, col. 2 – p. 98, col. 1. The pharmacological activity of urea, including moisturizing, desquamating antimicrobial, and anti-inflammatory action, are disclosed on p. 98, and its moisturizing effect is discussed throughout the article. The reference teaches urea increases the therapeutic activity of other pharmaceutical substances, and in Table 3 shows the use of urea in combination with anti-inflammatory agents, retinoid or others in the weight ratio of 10: 0.3 to 10: 5, which meets instant claims 23-25. The reference recommends formulating urea-containing compositions in the form of emulsion lotion or cream, meeting instant claims 2, 3, and 38. See p. 102, col. 2. In instant claim 37, examiner views that the limitation on the moisturizing effect of the composition is what is expected of based on the teaching of the combined references.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of Hoppe by incorporating urea in the composition, as suggested by Raab, because of the expectation of producing cosmetic and/or dermatological composition with enhanced therapeutic effect of

Art Unit: 1619

coenzyme Q10 and/or enhanced moisturizing effect. The skilled worker also would have been motivated to further add soothing agents in the composition, as taught by Raab.

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Obha et al. (U.S. Pat. No. 5683704, teaching cosmetic composition comprising 1-20 wt % of urea and 0.01-1 wt % of dl- α -tocopheryl 2-L-ascorbyl phosphate for antioxidant and humectant effects).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-305-3593.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on 703-308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner
November 5, 2001


DIANA DUDASH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600